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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 10/815,773                    | 04/02/2004  | Tadashi Oshima       | 0505-1292PUS1       | 9958             |
| 2292                          | 7590        | 02/02/2006           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH |             |                      | NAGY, MARC I        |                  |
| PO BOX 747                    |             |                      | ART UNIT            |                  |
| FALLS CHURCH, VA 22040-0747   |             |                      | PAPER NUMBER        |                  |

3748

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/815,773

Applicant(s)

OSHIMA ET AL.

Examiner

Marc I. Nagy

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/23/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/23/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/02/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 04/02/2004 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

3. The drawings were received on 12/23/2005. These drawings are acceptable.

### ***Election/Restrictions***

4. Applicant's election of Group I, claims 1-14, in the reply filed on 12/23/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Exhaust pipe insulator attaching structure for saddle-riding vehicle.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Amagai et al. (U.S. Patent No. 4,085,816). Amagai et al. discloses a heat insulator attaching structure for a vehicle exhaust pipe (exhaust tube 12), comprising: a heat insulator with a cross-section orthogonal to an extending direction thereof being curved substantially into an arc shape (generally cylindrical heat shielding plate 30) is attached to an exhaust pipe of a vehicle engine so as to allow distance therebetween; an attachment member attached to an inner-peripheral face of the heat insulator, the attachment member being formed with a curved arc-shaped contact portion (embossed sections 32 and 34) and an attachment portion, the attachment portion being formed on an outward side of the arc-shaped contact portion in a radial direction thereof so as to allow distance therebetween for attaching the attachment member to the inner-peripheral face of the heat insulator an inner-peripheral face of the arc-shaped contact portion of the attachment member contacting an outer-peripheral face of the exhaust pipe; and a band member fitted around an outer-peripheral face of the arc-shaped contact portion of the attachment member and the outer-peripheral face of the exhaust pipe (clamping bands 36 and 38), thereby fastening the attachment member to the exhaust pipe (see Fig. 5A).

Art Unit: 3748

8. In regards to claim 2, Amagai et al. discloses the heat insulator attaching structure as discussed in claim 1 above, wherein blocking edge portions are formed in the attachment member, the blocking edge portions rising on the outer-peripheral face side, at each of two curved edge portions of the arc-shaped contact portion (refer to edges of embossed sections 32 and 34; see Figs. 5A, 5E).

9. In regards to claim 3, Amagai et al. discloses the heat insulator attaching structure as discussed in claim 2 above, wherein the attachment portions are formed in the attachment member (embossed sections 32 and 34), each on an opposite side of each of the blocking edge portions to the arc-shaped contact portion (defined on opposite ends of each embossed section; see Figs. 5B, 5C).

10. In regards to claim 4, Amagai et al. discloses the heat insulator attaching structure as discussed in claim 4 above, wherein the band member (clamping bands 36 and 38) fits between the blocking edge portions (refer to Fig. 5A where clamping bands 36 and 38 fit into upper embossed sections 32 and 34, respectively; see also Fig. 5B, 5C).

11. In regards to claim 5, Amagai et al. discloses the heat insulator attaching structure as discussed in claim 2 above, wherein the blocking edge portions extend in a radial direction between the exhaust pipe and the heat insulator (see Figs. 5B, 5C), a space being provided between the exhaust pipe and heat insulator (space defined between the exhaust tube 12 and the heat shielding plate 30).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amagai et al. (U.S. Patent No. 4,085,816) in view of Nozaki (U.S. Patent No. 6,438,949). In regard to claims 6 and 7, Amagai et al. discloses the heat insulator attaching structure as discussed in claim 1 above, wherein the exhaust pipe and respective heat shield includes a linear section, but lacks a curved portion. Nozaki teaches the design of a substantially J-shaped exhaust pipe and respective heat shield with a curved portion (see Figs. 2, 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a heat shield with a curved portion since many common exhaust systems have exposed, curved portions, especially in the realm of motorcycles and all-terrain vehicles.

15. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki (U.S. Patent No. 6,287,354) in view of Amagai et al. (U.S. Patent No. 4,085,816). In regards to claim 8, Nozaki discloses a saddle-riding vehicle (four-wheeled buggy V) with an engine (engine E), comprising: an air cleaner attached to a rear side of the engine (see Fig. 1) having an air cleaner element (air filter 5) disposed in an upper portion inside an air cleaner case (air cleaner case 1) (see Fig. 3); but Nozaki fails to disclose a heat insulator attaching structure. Amagai et al. discloses a heat insulator attaching structure for a vehicle exhaust pipe (exhaust tube 12), comprising: a heat insulator with a cross-section orthogonal to an extending direction thereof being curved substantially into an arc shape (generally cylindrical heat shielding plate 30) is attached to an exhaust pipe of a vehicle engine so as to allow distance therebetween; an attachment member attached to an inner-peripheral face of the heat insulator, the attachment member being formed with a curved arc-shaped contact portion (embossed sections 32 and 34) and an attachment portion, the attachment portion being formed on an outward side of the arc-shaped contact portion in a radial direction thereof so as to allow distance therebetween for attaching the attachment member to the inner-peripheral face of the heat insulator an inner-peripheral face of the arc-shaped contact portion of the attachment member contacting an outer-peripheral face of the exhaust pipe; and a band member fitted around an outer-peripheral face of the arc-shaped contact portion of the attachment member and the outer-peripheral face of the exhaust pipe (clamping bands 36 and 38), thereby fastening the attachment member to the exhaust pipe (see Fig. 5A). It would have been obvious to one having

Art Unit: 3748

ordinary skill in the art at the time the invention was made to use the heat attaching structure on a saddle-riding vehicle, since many saddle-riding vehicles have exposed exhaust pipes that could heat and cause the operator discomfort.

16. In regards to claim 9, the modified Nozaki discloses the heat insulator attaching structure as discussed in claim 8 above, wherein blocking edge portions are formed in the attachment member, the blocking edge portions rising on the outer-peripheral face side, at each of two curved edge portions of the arc-shaped contact portion (Amagai et al.; refer to edges of embossed sections 32 and 34; see Figs. 5A, 5E).

17. In regards to claim 10, the modified Nozaki discloses the heat insulator attaching structure as discussed in claim 9 above, wherein the attachment portions are formed in the attachment member (Amagai; embossed sections 32 and 34), each on an opposite side of each of the blocking edge portions to the arc-shaped contact portion (Amagai; defined on opposite ends of each embossed section; see Figs. 5B, 5C).

18. In regards to claim 11, the modified Nozaki discloses the heat insulator attaching structure as discussed in claim 10 above, wherein the band member (Amagai; clamping bands 36 and 38) fits between the blocking edge portions (Amagai; refer to Fig. 5A where clamping bands 36 and 38 fit into upper embossed sections 32 and 34, respectively; see also Fig. 5B, 5C).

19. In regards to claim 12, the modified Nozaki discloses the heat insulator attaching structure as discussed in claim 9 above, wherein the blocking edge portions extend in a radial direction between the exhaust pipe and the heat insulator (Amagai; see Figs. 5B,

5C), a space being provided between the exhaust pipe and heat insulator (Amagai; space defined between the exhaust tube 12 and the heat shielding plate 30).

20. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki (U.S. Patent No. 6,287,354) in view of Amagai et al. (U.S. Patent No. 4,085,816) as applied to claim 8 above, and further in view of Nozaki (U.S. Patent No. 6,438,949). In regard to claims 13 and 14, the modified Nozaki (6,287,354) discloses the heat insulator attaching structure as discussed in claim 8 above, wherein the exhaust pipe and respective heat shield includes a linear section, but lacks a curved portion. Nozaki (6,438,949) teaches the design of a substantially J-shaped exhaust pipe and respective heat shield with a curved portion (see Figs. 2, 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a heat shield with a curved portion since many common exhaust systems have exposed, curved portions, especially in the realm of motorcycles and all-terrain vehicles.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hoeptner, III, (U.S. Patent No. 4,955,193) discloses an adjustable heat shield for motorcycle exhaust pipe; Metzger (U.S. Patent No. 5,036,947) discloses an exhaust pipe shield; Wolf et al. (U.S. Patent No. 5,603,297) discloses a heat shield; Dooley (U.S. Patent No. 6,408,980) discloses an exhaust pipe and muffler for motorcycle that does not heat discolor; Tsuruta et al. (U.S. Patent No. 6,530,443) discloses a structure of attaching heat insulation; Dooley (U.S. Patent No. 6,715,581)

Art Unit: 3748


discloses an exhaust pipe and muffler for motorcycle that does not heat discolor; Martin (U.S. Patent Publication No. US 2004/0045756 A1) discloses safety protectors for motorcycle exhaust pipes; Tsuruta (U.S. Patent Pub. 2004/0083714 A1) discloses a heat shield for internal combustion engine exhaust system.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc I. Nagy whose telephone number is 571-272-2758. The examiner can normally be reached on Monday - Friday 8 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc I. Nagy

  
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